

Remarks/Arguments:

Section 103 Rejections

Claims 1-3, 8-12, 18 and 19 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,267,474 to Mochizuki (hereinafter “Mochizuki”) in view of U.S. Patent No. 6,193,354 to Ito (hereinafter “Ito”) and U.S. Patent No. 3,708,798 to Hildenbrand et al. (Hereinafter “Hildenbrand”). Applicant respectfully traverses.

The Office Action alleges that the limitation “wherein the working container and the releasable flexible reservoir have an open connection between them such that during normal operation these form communicating vessels”, which was added to claim 1 in the January 7, 2009 Amendment and Response, is known from Hildebrand. The Office Action alleges that it would be obvious for one of ordinary skill in the art to apply a piezoelectrical print head according to Ito in the printing device according to Mochizuki and to implement in that combination a connection between the working container and the releasable, flexible reservoir, without the need of additional elements like a pump, as is taught by Hildebrand. Applicant respectfully traverses.

The air bubble trap according to Hildenbrand is not suited for use in a printing device according to the invention. More importantly in relation to the Office Action, combining Hildenbrand with Mochizuki would destroy the function, purpose and intent of Mochizuki. For example, as taught in Mochizuki, column 1, lines 20-24, as well as in several other paragraphs relating to the composition of the ink bag material (see for example, Mochizuki, column 3, line 16 ff, noting the criticality of gas impermeable ink bags) it is important that the ink be degassed, otherwise air contained in the ink would deteriorate the performance of jetting an ink droplet. Indeed, the teachings of Mochizuki are clearly directed to avoiding any possible contact of its ink with air as Mochizuki teaches that its ink bags must be air impermeable, it must be a gas barrier.

Now, the manifold 12 in Hildenbrand contains an air bubble trap 26 at the top; see figure 1 and column 3, line 33 ff, abstract and the like. The air bubble trap 26 operates to regulate pressure fluctuations within the manifold. According to column 3, line 53, another function of the air trap 26 is to accumulate and trap bubbles of air and to prevent air bubbles in the ink from passing through the system into the printing head 14. Thus, the one of ordinary skill in the art would not apply a manifold including an air bubble trap as taught in Hildenbrand in an ink jet recording device known from Mochizuki because the strict measures relating to the degassed ink would be counteracted by the presence of the air bubble trap in the manifold according to Hildenbrand. In other words, Hildenbrand necessarily introduces air, as required by its air space, in contact with its ink in direct contrast to the teachings of Mochizuki. Thus, one of ordinary skill in the art would not be motivated to combine Mochizuki and Hildenbrand Mochizuki teaches away from the system of Hildenbrand and/or Hildenbrand would destroy the purpose, intent and function of Mochizuki.

Moreover, there is absolutely no reason for one of ordinary skill in the art to incorporate the “open system” of Hildebrand in the combined Mochizuki-Ito system. Such a combination would necessarily frustrate the operation of a printing device according to Mochizuki, in particular the joint operation of pump 34 and electromagnetic valves 28, 35 and 39 maintaining the ink level in subtank 20.

In establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* It is only through hindsight reconstruction and very selective picking and choosing while ignoring divergent teachings does the Examiner attempt to reach the present invention through the combination of Mochizuki, Ito and Hildenbrand. It is also well established, however, that hindsight reconstruction of a reference does not present a *prima facie* case of obviousness, and any attempt at hindsight

reconstruction using Appellant's disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445-46 (Fed. Cir. 1993). Such hindsight reconstruction by the Examiner is clear as, *inter alia*, Hildenbrand not only teaches away from the present invention but also teaches away from the system of Mochizuki.

Thus, Mochizuki, Ito and Hildenbrand, individually or in combination, fail to teach or suggest the present invention as claimed. Accordingly, reconsideration and withdrawal of the rejections of claims 1-3, 8-12, 18 and 19 under 35 U.S.C. § 103(a) are respectfully requested.

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Mochizuki and Ito in view of U.S. Patent Application Publication No. 2003/0071722 to Cole (hereinafter "Cole"). Applicant respectfully traverses.

For the record the Office Action fails to present a *prima facie* case of obviousness here because, *inter alia*, the Hildenbrand reference is not being applied. Accordingly, Applicant respectfully submits that at least the finality of the present Office Action must be withdrawn.

Assuming *arguendo* that the exclusion Hildenbrand was just an oversight in the Office Action, the inclusion of Hildenbrand here still does not present a *prima facie* case of obviousness. Cole relates to a dump truck tail gate latch monitor. Although it shows a tilting mechanism, this topic is far removed from the technical field of piezo drop-on-demand printing that one of ordinary skill in the art would not be motivated to combine the teachings of Cole as asserted by the examiner. In establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* It is only through hindsight reconstruction and very selective picking and choosing while ignoring divergent teachings does the Examiner attempt to reach the present invention through the combination of Mochizuki, Ito, (presumably) Hildenbrand and Cole. It is also well established, however, that

hindsight reconstruction of a reference does not present a *prima facie* case of obviousness, and any attempt at hindsight reconstruction using Appellant's disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445-46 (Fed. Cir. 1993). Such hindsight reconstruction by the Examiner is clear as, *inter alia*, Cole is related to a dump truck tail gate latch monitor.

Furthermore, the examiner has asserted an overly broad interpretation of claims 4-7 in an attempt to provide analysis for the *Graham* factors under a Section 103 obviousness rejection. Dependent claims 4-7 cannot be read in absence of the independent claim. Independent claim 1 clearly describes that the releasable flexible reservoir is for storing degassed printing medium. The flexible reservoir is in communication with a flexible working container which is arranged in a fixed position relative to the spray nozzle. The mere movement of fluid by gravity, as asserted by the examiner, is not the proper inquiry. Rather, the examiner must consider the movement of fluid from one reservoir or container to another container.

In such a consideration, one of ordinary skill in the art would not be motivated to by the dump truck teachings of Cole in an attempt to arrive at the present invention because, *inter alia*, Cole is not directed in the movement of fluid from one container to another container. Assuming *arguendo* that the examiner may properly consider the open bed 5 of Cole's dump truck as a "container", Cole fails to teach or suggest the transport of material from the bed 5 into another container. The examiner, however, asserts that the open space outside of Cole's bed 5 is another "working container". This cannot be a proper assertion because, *inter alia*, the open space is the final disposition of the product of Cole. In the terms of the present claims, the "open space" of Cole would be the substrate onto which drops of printing medium are deposited via the spray nozzle, as set forth in independent claim 1. In other words, Cole fails to teach or suggest a "second" container.

Thus, Mochizuki, Ito, (presumably) Hildenbrand and Cole, individually or in combination, fail to teach or suggest the invention as presently defined by claims 4-7.

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Reconsideration and withdrawal of the rejections of claims 4-7 under 35 U.S.C. § 103(a) are respectfully requested.

Summary

Therefore, Applicants respectfully submit that independent claim 1, and all claims dependent therefrom, are patentably distinct. This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,

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